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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,754	10/10/2000	Jeffrey L. Huckins	ITL 0481 US (P10029)	4789
21906 7590 03/25/2008 TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631				
EXAMINER DONAGHUE, LARRY D				
ART UNIT 2154		PAPER NUMBER		
MAIL DATE 03/25/2008		DELIVERY MODE PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY L. HUCKINS

Appeal 2007-3408
Application 09/686,754
Technology Center 2100

Decided: March 25, 2008

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-30. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM IN PART.

THE INVENTION

The disclosed invention relates generally to managing remote clients. More particularly, Appellant's invention relates to a client-server system that transmits messages by using identifiers and using the identifiers to perform tasks (See Spec. 4, ll. 21-24).

Independent claim 1 is illustrative of the invention:

1. A method comprising:
receiving on a client a message from a server addressed
to said client; and
scheduling a data upload session based on said message.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Reisacher	US 5,978,845	Nov. 2, 1999
Lakey	US 6,078,954	June 20, 2000

Hein, SNMP, Simple Network Management Protocol, Version 2, 1994, 339-40.

THE REJECTIONS

1. Claims 1, 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30 stand rejected under 35 U.S.C. §102(e) as being anticipated by Reisacher.

2. Claims 4, 5, 8-10, 14, 17-19, 25, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reisacher in view of Hein.

3. Claims 2, 3, 12, 13, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reisacher in view of Lakey.

Appellant has not directly addressed the Examiner's final rejection of claims 2, 3, 12, 13, and 21 in the Briefs. However, on page 5 of the principal Brief, Appellant expressly states that "[c]laims 1-30 are rejected and are the subject of this Appeal Brief." Because Appellant has failed to traverse the Examiner's rejection of these claims in the Briefs, we *pro forma* sustain the Examiner's rejection of claims 2, 3, 12, 13, and 21 as being unpatentable over Reisacher in view of Lakey.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

In rejecting claims under 35 U.S.C. § 103, "[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection

[under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Briefs to show error in the proffered *prima facie* case.

ANALYSIS

Anticipation under 35 U.S.C. § 102

Claims 1, 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30

We consider the Examiner’s rejection of claims 1, 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30 as being anticipated by Reisacher. We note that Appellant’s Brief does not provide separate arguments for claims 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30. Appellant submits arguments for the first time regarding claim 7 in the Reply Brief (Reply Br. 2, ll. 22-26). We decline to consider this new argument as untimely. See *Optivus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d 978, 989 (Fed. Cir. 2006) (an issue not raised in an opening brief is waived). Since Appellant’s arguments have otherwise treated these claims as a single group which stand or fall together, we select independent claim 1 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii).

We note that Appellant has not contested the Examiner’s finding that Reisacher discloses the limitations of “receiving on a client a message from a server addressed to said client,” as recited in claim 1.

Nevertheless, Appellant contends that Reisacher fails to teach a scheduled upload session based on a received message (App. Br. 11, l. 18). According to the Appellant, Reisacher teaches that an SNMP relay which

waits for receipt of the outstanding responses, and upon receipt thereof, rebuilds a full SNMP response (App. Br. 11, ll. 11-17). Thus, Appellant asserts that Reisacher fails to teach an upload session that is “scheduled” based on a received message as recited in claim 1. In addition, Appellant argues that the upload session in Reisacher is random because the full SNMP response occurs whenever the responses from the agents are received (App. Br. 11, ll. 20-23). We note that claim 1 is silent with regards to the source or recipient of the upload.

Claim Construction

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). Here, we broadly but reasonably construe the claim term “scheduling” to read on a series of planned events.

In the Reply Brief, Appellant has submitted a dictionary definition of “scheduling” (Reply Br. 1). We decline to construe Appellant’s claims in light of this untimely extrinsic evidence. *See* 37 C.F.R. § 41.41(a)(2) (A reply brief shall not include any new evidence).

As noted by the Examiner, the term “schedule” is not further defined in claim 1. The Examiner has determined that Reisacher teaches a time ordering of events, i.e., (1) receipt of all outstanding responses, and (2), transmitting a full SNMP response after receipt of all of the outstanding responses (Ans. 4, para. 17). We agree with the Examiner that Reisacher teaches that the full SNMP response is scheduled because it does not take place until after all of the outstanding responses have been received. Thus, we find Reisacher’s full SNMP response is a planned event, and is not

random as asserted by Appellant. Therefore, we agree with the Examiner's finding that Reisacher discloses scheduling an upload session based on said message, as recited in claim 1. We conclude that Appellant has not shown the Examiner has erred in rejecting independent claim 1.

Accordingly, we sustain the Examiner's rejection of claim 1 as being anticipated by Reisacher. Pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the representative claim alone. Thus, we sustain the Examiner's rejection of claims 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30 as being anticipated by Reisacher.

Obviousness under 35 U.S.C. § 103

We consider next the Examiner's rejection of claims 4, 5, 8-10, 14, 17-19, 25, and 27 as being unpatentable over Reisacher in view of Hein.

Combinability under 35 U.S.C. § 103

Appellant contends that the Examiner has not established prima facie obviousness because the final rejection failed to set forth a rationale to modify or combine the references (App. Br. 12, ll. 7-9).

We disagree because the Examiner has provided a rationale for combining Reisacher and Hein. In particular, the Examiner has found that since both Reisacher and Hein are directed to SNMP, one of ordinary skill would have been motivated to examine all aspects of the protocol, such as those aspects taught by Hein (Ans. 4 para. 20). Thus, Appellant has not shown the Examiner erred in combining Reisacher and Hein.

Claims 4 and 5

We consider the Examiner's rejection of claims 4 and 5 as being unpatentable over Reisacher in view of Hein. Appellant contends that the cited references fail to teach the elements recited in claims 4 and 5 (App. Br, 12).

We disagree because the "identifier" elements of claims 4 and 5 are non-functional descriptive material that fails to distinguish these claims over the cited references. In a precedential decision, an expanded Board panel recently held that elements that do not affect the claimed process are non-functional material and are merely descriptive. *See Ex parte Nehls*, (BPAI 2008) (precedential) (Appeal No. 2007-1823).¹

Here, claim 4 recites receiving a message including *an identifier which specifies a task to perform on a storage device*. Claim 5 recites receiving a message including *an identifier indicating a change to a partition on said storage device* (emphasis added). We consider these claims as merely being directed to a step of receiving a message that includes an identifier coupled with a statement of intended use. The step of receiving a message does not change according to the particular type of identifier received. Thus, the elements recited in claims 4 and 5 do not provide any new and unobvious functions to the steps recited in claim 1, from which claims 4 and 5 depend. Accordingly, we sustain the Examiner's rejection of claims 4 and 5 as being unpatentable over Reisacher in view of Hein.

Claims 9 and 10

¹ See <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>

We consider next the Examiner's rejection of claims 9 and 10 as being unpatentable over Reisacher in view of Hein. Appellant contends that there is no discussion of any identifier used to upload and to specify the information to upload to the server (App. Br. 12, ll. 26-31). Claim 9 further recites uploading the specified information to said server.

The Examiner stated that this element is expressly taught by Reisacher (Ans. 6, ll. 1-4). The Examiner points to Reisacher's teaching of "analyzing a request received from the network under a predetermined network management protocol to identify each management operation to be performed and to identify an agent for performing each identified operation" (Reisacher, col. 3, ll. 59-63). This portion of Reisacher is apparently interpreted by the Examiner to mean that the identified operations produce the data, which also would identify the data to be uploaded (Ans. 6).

However, we agree with Appellant that the evidence relied on by the Examiner falls short of fairly teaching and/or suggesting "including extracting from said message an identifier which specifies the information to upload to said server and uploading the specified information to said server," as required by the express language of dependent claim 9. Accordingly, we reverse the Examiner's rejection of claim 9 and also claim 10 (which depends from claim 9) as being unpatentable over Reisacher and Hein.

Claim 14

We consider next the Examiner's rejection of claim 14 as being unpatentable over Reisacher in view of Hein. Appellant contends that the Examiner has not indicated any instructions that decode a command within a

message to modify the storage of information on a storage device (App. Br. 13, ll. 1-4).

We disagree because claim 14 is directed to non-functional descriptive material. We consider claim 14 as merely being directed toward a step of storing instructions coupled with a statement of intended use. We note that the recited function of storing instructions does not change according to the particular type of instructions. Thus, the instructions of claim 14 do not provide any new and unobvious functions to the functional language recited in claim 11, from which claim 14 depends. Because the non-functional descriptive material of claim 14 fails to distinguish the claim over the cited references, we sustain the Examiner's rejection of claim 14 as being unpatentable over Reisacher in view of Hein.

Claims 18 and 19

We consider next the Examiner's rejection of claims 18 and 19 as being unpatentable over Reisacher in view of Hein. Appellant contends the cited references fail to disclose or suggest extracting from said message an identifier which specifies the information to upload to said server and upload the specified information to said server, as recited in claim 18. The Examiner contends that Reisacher discloses this feature (Ans. 3, para. 10). The Examiner further refers to the arguments presented regarding claim 4 (*Id.* at para. 23). The Examiner points to Reisacher's description of "analyzing a request received from the network under a predetermined network management protocol to identify each management operation to be performed and to identify an agent for performing each identified operation" (Reisacher, col. 3, ll. 59-63).

While we agree with the Examiner that the cited references, most notably Reisacher, teach and/or suggest the use of an identifier to perform a specified task, we nevertheless disagree with the Examiner's determination that the cited references teach or suggest extracting an identifier which specifies information to be uploaded, *and uploading the specified information*, as required by the language of claim 18 (emphasis added). Accordingly, we reverse the Examiner's rejection of claim 18 and also claim 19 (which depends from claim 18) as being unpatentable over Reisacher and Hein.

Claims 8, 17, 25, and 27

We consider next the Examiner's rejection of claims 8, 17, 25, and 27 as being unpatentable over Reisacher in view of Hein. Since Appellant's arguments have treated these claims as a single group which stand or fall together, we select claim 8 as the representative claim for this group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding claim 8, Appellant notes that Hein is relied upon to teach extracting a specified time from a message and uploading the data at the specified time (App. Br. 13, ll. 11-13). Appellant contends that "[n]othing in Hein seems to *enable* extracting a time and uploading information at a specified time" (*Id.* ll. 13-15) (emphasis added).

While a reference must enable someone to practice the invention in order to anticipate under § 102, a non-enabling reference may qualify as prior art for the purpose of determining obviousness under § 103. *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1578 (Fed. Cir. 1991). Moreover, U.S. Patents are presumed to be enabled and otherwise fully comply with the requirements of 35 U.S.C. § 112, first paragraph.

Therefore, we find unpersuasive Appellant's argument directed to the question of whether Hein is an *enabling* reference. We decline to consider Appellant's additional arguments presented for the first time in the Reply Brief as untimely (*see* Reply Br. 3). *See Optimus Tech., Inc. v. Ion Beam Applications S.A.*, 469 F.3d at 989. Because Appellant has not shown error in the Examiner's prima facie case, we sustain the Examiner's rejection of representative claim 8 and also claims 17, 25, and 27 (which fall therewith) as being unpatentable over Reisacher and Hein.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown the Examiner erred in rejecting claims 1, 6, 7, 11, 15, 16, 20, 22-24, 26, and 28-30 under 35 U.S.C. § 102(e) for anticipation, and claims 2-5, 8, 12-14, 17, 21, 25, and 27 under 35 U.S.C. § 103(a) for obviousness. However, we conclude that Appellant has shown the Examiner erred in rejecting dependent claims 9, 10, 18, and 19 under 35 U.S.C. § 103(a) for obviousness.

DECISION

The decision of the Examiner rejecting claims 1-8, 11-17, and 20-30 is affirmed.

The decision of the Examiner rejecting claims 9, 10, 18, and 19 is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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TROP PRUNER & HU, PC
1616 S. VOSS ROAD, SUITE 750
HOUSTON TX 77057-2631